

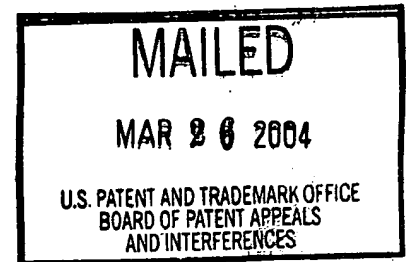
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte KAREN SHANNON

Appeal No. 2004-0727
Application No. 09/690,173

ON BRIEF



Before SCHEINER, ADAMS and GREEN, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the
examiner's final rejection of claims 32-48, which are all the claims pending in the
application.

Claims 38 and 41 are illustrative of the subject matter on appeal and are
reproduced below:

38. A kit for use in linearly amplifying mRNA, said kit comprising:
an oligonucleotide promoter-primer comprising an RNA polymerase
promoter sequence; and
instructions to convert the mRNA to cDNA, and to then transcribe
the cDNA into RNA in the presence of a reverse transcriptase that is
rendered incapable of RNA-dependent DNA polymerase activity
during this transcription step.

41. A kit for use in linearly amplifying mRNA, said kit comprising:
- (a) an oligonucleotide promoter-primer comprising an RNA polymerase promoter sequence;
 - (b) an RNaseH- polymerase; and
 - (c) an RNaseH+ polymerase.

The references relied upon by the examiner are:

Wang et al. (Wang) 5,932,451 Aug. 3, 1999

Phillips et al. (Phillips), "Antisense RNA Amplification: A Linear Amplification Method for Analyzing the mRNA Population from Single Living Cells," Methods: A companion to Methods in Enzymology, Vol. 10, pp. 283-88 (1996)

GROUND OF REJECTION

Claims 32-48¹ stand rejected under 35 U.S.C. § 102(e) as anticipated by Wang.

Claims 32-36 and 39-40 stand rejected under 35 U.S.C. § 102(b) as anticipated by Phillips.

We affirm the rejection over Wang. Having disposed of all claims on appeal, we find it unnecessary to reach the merits of Phillips.

CLAIM GROUPING

According to appellant (Brief, page 5), "[c]laims 32-48 stand together." Since all claims stand or fall together, we limit our discussion to representative independent claim 41. Claims 32-40 and 42-48 will stand or fall together with

¹ We note that appellant's statement of the claims under rejection is incorrect. According to appellant (Brief, page 4), Wang was applied to claims 38 and 41-48. To the contrary, as set forth in the Final Office Action (Paper No. 11, page 2), "[c]laims 32-37 and 39-40 remain rejected and claims 38, and 41-48 are [rejected] under 35 U.S.C. 102(e) as being anticipated by Wang...." We note that in appellant's response immediately preceding the Final Office Action, claim 38 was amended and claims 41-48 were added. See Paper No. 10, pages 1-2. The Advisory Action maintained the rejection of claims "32-48 for the reasons of record set forth in the Office Action mailed 5-08-2002 [the Final Office Action, Paper No. 11]."

claim 41. In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991).

DISCUSSION

Anticipation under 35 U.S.C. § 102 requires that a single prior art reference disclose each and every limitation of the claimed invention. Electro Med. Sys. S.A. v. Cooper Life Sci., 34 F.3d 1048, 1052, 32 USPQ2d 1017, 1019 (Fed. Cir. 1994). As we understand the rejection of record, Wang discloses kits comprising containers of various reagents, including those set forth in appellant's claim 41. Accordingly, the examiner concludes (Answer, page 4), Wang "teach each and every aspect of the instant invention thereby anticipating [a]ppellant's claimed invention."


While claim 41 does not include a limitation drawn to "printed matter," such as instructions, appellant spends the bulk of the Brief and Reply Brief discussing "printed matter." According to appellant (Brief, page 14),

Wang fails to teach a kit containing the instructional element of the present claims because Wang is concerned with an entirely different method.... As such, Wang fails to teach each and every element of the claims. Because Wang fails to teach each and every element of the claimed kit, e.g., the instructions, Wang fails to anticipate [c]laims 38 and 41-48....

Apart from appellant's argument concerning "printed matter," which is not a limitation of claim 41, appellant identifies no other error in the rejection of claim 41 over Wang. Accordingly, we are compelled to affirm the rejection of claim 41 under 35 U.S.C. § 102(e) as anticipated by Wang. As set forth above, claims 32-40 and 42-48 fall together with claim 41.

No time period for taking any subsequent action in connection with this
appeal may be extended under 37 CFR § 1.136(a).

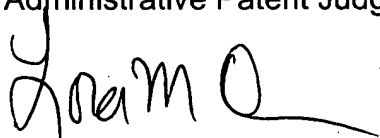
AFFIRMED



Toni R. Scheiner
Administrative Patent Judge



Donald E. Adams
Administrative Patent Judge



Lora M. Green
Administrative Patent Judge

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